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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,389	08/19/2003	Jonathan D. Zook	08303.0042-06	6131

22852 7590 03/04/2005

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EXAMINER

TRUONG, DUC

ART UNIT PAPER NUMBER

1711

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,389

Applicant(s)

ZOOK ET AL

Examiner

Duc Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-27 and 31-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Applicants argue that claims 22-27 and 31-36 are entitled to an effective filing date corresponding to Applicants' domestic priority application filing date, i.e., the present application is a CIP of U.S. Application No. 08/802,130 filed September 19, 1997, now U.S. Patent 5,912,319.

Note that the effective filing date of February 19, 1997 is before the March 9, 2000 priority date of the '168 patent and the filing date of the '135 Application.

Applicants also submitted Appendix C, pages 17-21 to show the specification of the parent application from which Applicants claim priority fully supports Applicants' claims 22-27 and 31-36.

Note that the formula of claim 22 of the instant application and from the specification of the parent case are different, for the following reasons:

(1) the repeating unit of the methylene on the left side and in the right side of a (-R2-O-) with m repeating unit of the instant claim 22 is p and q (p is an integer between 2 and 6 and q is an integer between 1 and 5) whereas in the parent application $p=q=2$. This means the instant claim 22 is broader than the supporting disclosure of the parent case. In the case, if p and/or q is from 3-5 or 6, then the instant claim 22 does not have support from the specification of the parent case.

(2) Note that p and q from the formula of the parent case come from (R2-O-) with m repeating unit, which is between the methylene on the left side and on the right side of said unit, of the instant claim 22. Therefore, p and q are different since p and q are methylene repeating unit (the instant claim 22) and are derived from R2 (in the

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reference). Insert these limitations into the formulae, the polythioether of the instant claim and in the parent case is different.

Claim 31 of the instant application also has been compared with the parent 08/802,130 specification, as follows:

Note that A in the formula III of the reference denotes a structure having the formula I, which is differed at least from the formula of claim 31 for the reasons as stated above.

Since the formulae of the instant claims do not have support from the specification of the parent case, then the instant application is not entitled to the effective filing date of the parent application NO 08/802,130 filed September 19, 1997 now U.S. Patent 5,912,319.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-27 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zook et al (6,525,168).

Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over 10/368,135..

The reference discloses the formula of a polythioether composition.(see Abstract and at col. 2, line 25 et seq. of '168) and a curable composition (see claim 9 of the '135 application).

The disclosures of the reference differ from the instant claims in that they do not disclose the claimed formula with so many variations.

However, the references do disclose the same or similar formula to form the same or similar products of the claimed formula. Applicants have demonstrated a fantastic job to compare, analyze and how to arrived at the claimed formulae from the teachings of the references.(see Remarks, pages 22-31)

Therefore, it would have been obvious to one of ordinary skill in the art to select the reactants from the references within the limitations of the instant claims since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results. There is no showing of unexpected results derived from said selection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 571-272-1081. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Ductruong', is positioned above the printed name.

DUCTRUONG
PRIMARY EXAMINER